



cev
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,040	11/28/2000	Maifred Boldy	DE919990090US1	6054

25299 7590 11/18/2003

IBM CORPORATION
PO BOX 12195
DEPT 9CCA, BLDG 002
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

ABDULSELAM, ABBAS I

ART UNIT	PAPER NUMBER
----------	--------------

2674

DATE MAILED: 11/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,040

Applicant(s)

BOLDY, MANFRED

Examiner

Abbas I Abdulsalam

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 09/10/03 have been fully considered but they are not persuasive.

Applicant argues the cited references Bishop (USPN 5529415) and Walker (USPN 3787898) alone or in combination do not teach the use of adhesive bonding directly to the fingertip. Applicant also argues that the cited references do not teach a dome, which is rotationally symmetric. Applicant further argues that the cited references do not teach a dome having an axial opening located opposite to the base surface. In addition, Applicant argues that the cited references do not teach a pin extending from the base surface of the dome through the axial opening of the dome.

With respect to the adhesive bonding, as shown in the art rejection below, walker teaches the use of thumb (15) and fingers (16, 17) with adhesive materials, which will provide a gripping and a non-slipping means between the glove and the pen. It would have been obvious at the time the invention was made to utilize Walker's adhesive material between Bishops finger and the device (10).

Moreover, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to the arguments regarding the dome's symmetry and an axial opening, it is a matter of shape and size, and one of ordinary skill in the art would have chosen any configuration as

Art Unit: 2674

mentioned by Bishop in column 2, lines 18-36 as "... the invention is not limited in it's application to the details of construction and to the arrangement of the components set forth ... The invention is capable of other embodiments and of being practiced and carried in various ways... may be utilized as a basis for designing other structures..." The same teaching by Bishop holds true in response to applicant's argument regarding extending pin, coplanar configuration and exterior profile. It would have been to modify Bishop's device in the desired configuration.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop (USPN 5529415) in view of Walker (USPN 3787898).

Regarding claims 12, 17 and 21, Bishop teaches a device (100) which contains a finger portion (12) having a rounded first end (14) and an open second end (16) with the second end adapted for removable securement to a fingertip (128) of a user. Bishop discloses that the finger portion has a ballpoint pen tip (24) secured to the open-end portion (22) outwardly extending of the rounded first end (14). See col. 3, lines 50-65 and Fig. 1. However, Bishop does not disclose an adhesive layer joined to the base surface of the dome for securing the dome with the adhesive layer permitting repeated removal and rebounding with respect to the fingertip. Walker teaches

Art Unit: 2674

the use of a thumb (15) and fingers (16, 17) with adhesive material or other materials, which will provide a gripping and non-slipping means between the glove and the pen. See col. 4, lines 63-68, and col. 5, lines 1-3. For example, Walker teaches the use of fingers with adhesive portions (18, 19, 20) with respect to the areas of contact between the glove and the pen. See Fig. 6.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Bishop's fingertip pen writer system (Fig. 1) to adapt walker's use of adhesive contacting (18, 19, 20). One would have been motivated in view of the suggestion in Walker that the use of adhesive contacting technique is equivalent to the desired use of adhesive layer. The use of adhesive contacting technique (18, 19, 20) helps a writing pen gripped by the hand more firmly as taught by Walker.

In addition, it would have been obvious for one of ordinary skill in the art to ascertain that Bishop's pen tip (24) can be used for the desired actuation of small keys on miniature keyboards.

Bishop also teaches that the device (10) can be in any variations in size, materials shape, form, function and the manner of operation. See col. 4, lines 23-37. Hence it would have been obvious that specific designs of the dome with axial opening and dimensions as well as symmetric rotational profile are met by bishop's teaching of variations in shape, size and form.

Regarding claims 13, 19 and 23, Bishop teaches a fingertip pen writer system as shown in Fig. 1 and inspection of the Fig. 1 reveals pen tip (24) contacting the surface in the same plane.

Regarding claims 14, 20, 25, Walker teaches adhesive contact (18, 19, 20) and it would have been obvious to utilize the adhesive contact on Bishop's device in any desired manner.

Art Unit: 2674

Regarding claim 15, Bishop teaches a point pen tip (24) used for writing and it would have been obvious that the tip is hard enough to be able to write on the surface.

Regarding claims 16, 18, 22, 24, Bishop teaches the use the device (10) with variations in materials shapes and forms.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Abbas Abduselam** whose telephone number is **(703) 305-8591**. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard Hjerpe**, can be reached at **(703) 305-4709**.

Art Unit: 2674

Any response to this action should be mailed to:

Commissioner of patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314

Hand delivered responses should be brought to Crystal Park II, Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology center 2600 customer Service office whose telephone number is (703) 306-0377.

Abbas Abdulsalam

Examiner

Art Unit 2674

November 14, 2003



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600